



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,986	12/23/1998	SAM SCHWARTZ	17649-20	5361
34205	7590	03/06/2006	EXAMINER	
OPPENHEIMER WOLFF & DONNELLY LLP 45 SOUTH SEVENTH STREET, SUITE 3300 MINNEAPOLIS, MN 55402			KISHORE, GOLLAMUDI S	
			ART UNIT	PAPER NUMBER

1615

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/220,986	Applicant(s) SCHWARTZ, SAM	
	Examiner Gollamudi S. Kishore, Ph.D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,38,40-45 and 47-63 is/are pending in the application.
- 4a) Of the above claim(s) 38,40-45 and 47-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment dated 12-7-05 is acknowledged.

Claims 34, 38, 40-45, 47-63 are pending application.

The only claim included in the prosecution is 34.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Instant claim now recites " 10 part Dead salts to about 1 part said first ingredient wherein said second ingredient comprises a solid phase, and wherein the combination of said first ingredient with said second ingredient results in a single phase topical composition comprising said Dead sea salts **completely dissolved in said deionized water**" In this added limitation, the Dead sea salts are in higher amounts than the water. The specification on page 14 reciting these amounts (that is 10 parts to one part lotion) pertains to a scrubbing composition meaning that the salt is in the solid form in the composition and not in a completely dissolved state. In addition, the concept of adding the first part and the second part and

Art Unit: 1615

resulting in a solution is not present in the originally filed specification. Furthermore, as pointed out above, the 10 parts of the salt is per part of **lotion** as recited on page 14 of the specification and not per one part of deionized water. Since these limitations are not present in the originally filed specification, they are deemed to be new matter. It should be noted that the previously applied prior art of Stovraff shows that when 50 to 80 % of salt is present in 66.7 % water containing composition, the salt does not dissolve and the composition is gritty. Applicant now claims 90.90 % salt in the composition (10 parts per one part of lotion = 90.9 % salt). It should also be noted that 42 to 25 % of the first phase contains a lipid soluble material (which does not dissolve salts).

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 is confusing. The first line of the claim recites 'a topical composition comprising' implying that it is a single composition; yet the subsequent lines of the claim recite a first ingredient, which is a water-soluble lotion and a second ingredient which is a solid (dead sea salts) wherein the combination of the first and second ingredient results in a single phase composition wherein the dead sea salts are completely soluble in water. These subsequent lines are inconsistent with the single composition as evident from the first line of the claim. Furthermore, the

Art Unit: 1615

composition contains lipophilic compounds such as mineral oil, triglycerides and fatty acids along with an emulsifier. This means the composition is an emulsion, which is stabilized by an emulsifier and not a single-phase aqueous composition.

It should have been 'a glyceryl triester' and not 'glyceryl trimester' (lipid-soluble component). Also unclear is what applicant intends to convey by 'alginate derivative'. Alginate itself is a derivative of alginic acid. There is no specific definition of the term in the specification. Finally it should be pointed out that the Markush language is 'selected from the group consisting of' and not 'selected from the group consisting essentially of'. In view of applicant's amendment to the claims reciting 10 parts of salt per 1 part of deionized water wherein the salt is dissolved totally, the prior art rejections are withdrawn. However, the rejections could be reinstated.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 1615

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gollamudi S. Kishore, Ph.D whose telephone number is (571) 272-0598. The examiner can normally be reached on 6:30 AM- 4 PM, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gollamudi S Kishore, Ph.D
Primary Examiner
Art Unit 1615

GSK